

09 - 25 - 06
Appl. No. 09/276,233
Petition for Reconsideration of IDS

PATENT
Customer No. 22,852
Attorney Docket No. 7451.0011-01
Intertrust Ref. No.: IT-17 (US) IFK

CERTIFICATE UNDER 37 CFR § 1.10 OF MAILING BY "EXPRESS MAIL"

EV 746096415 US

September 22, 2006

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Date of Deposit

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By: Cheryl L. Franke

Cheryl L. Franke



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Talal G. SHAMOON et al.

Application No.: 09/276,233

Filed: March 25, 1999

For: METHODS AND APPARATUS
FOR PERSISTENT CONTROL
AND PROTECTION OF CONTENT

)
)
) Group Art Unit: 2165

)
) Examiner: PARDO, Thuy N.

)
)
) Confirmation No.: 1836

MAIL STOP PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PETITION FOR RECONSIDERATION OF INFORMATION DISCLOSURE
STATEMENT AFTER ISSUANCE OF NOTICE OF ALLOWANCE

Pursuant to 37 C.F.R. § 1.182 and § 1.97(f), and M.P.E.P. § 1002.02(b),

Applicants respectfully request that the Examiner consider an Information Disclosure Statement that was filed on March 11, 2004, but never entered into PAIR, for the above-referenced, allowed application.

Statement of Facts

Applicants filed an Information Disclosure Statement along with a Response to a Restriction Requirement on March 11, 2004 (see, stamped postcard at Exhibit A). The

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entire package was neither received nor entered into PAIR. Examiner Patrick Santos placed a courtesy call on July 29, 2004, to inquire whether Applicants' intended to abandon the case (see, Exhibit B). The Response was immediately emailed and also resent by facsimile on July 29, 2004 (see, Exhibit C).

On July 30, 2004, Andrew Schwaab, the attorney handling the case, spoke with Examiner Santos by phone to confirm receipt of the Response (see, Exhibit D). At this time, Examiner Santos confirmed that two boxes of IDS materials were in his office relating to the March 11, 2004 filing. Applicants were under the impression that the Information Disclosure Statement was not lost and would be entered into PAIR in due course.

On August 10, 2006, a Notice of Allowance was issued in this case by Examiner Thuy Pardo. During a routine examination of the file, it was discovered that this particular Information Disclosure Statement was not entered in PAIR and never considered by the Examiner.

The undersigned spoke with Examiner Pardo on September 8, 2006, regarding this situation. Examiner Pardo suggested filing this Petition.

Conclusion

The originally filed Information Disclosure Statement is enclosed as Exhibit E, along with a CD-ROM, for the Examiner's convenience. The Examiner is respectfully requested to consider the documents contained therein and return the initialed copy of the Form PTO/SB/08. Please charge the required fee of \$130.00, as specified in 37 C.F.R. § 1.17(f), to our Deposit Account No. 06-0916.

Appln. No. 09/276,233
Petition for Reconsideration of IDS

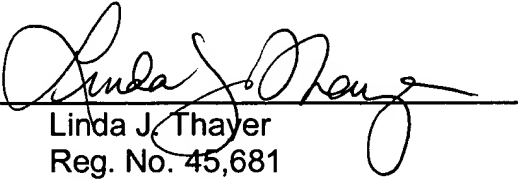
PATENT
Customer No. 22,852
Attorney Docket No. 7451.0011-01
Intertrust Ref. No.: IT-17 (US)

If any additional fees are necessitated in regard to the filing of this paper, please
charge the cost to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 22, 2006

By: 
Linda J. Thayer
Reg. No. 45,681

Finnegan Henderson Farabow
Garrett & Dunner L.L.P.
901 New York Ave., N.W.
Washington, D.C. 20001
Attorney direct (650) 849-6621

MCE/LIT/ABS

PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

In re Application of: SHAMOON et al.

Application No.: 09/276,233

Group Art Unit: 2171

Filed: March 25, 1999

Examiner: SANTOS, Patrick J.

For: METHODS AND APPARATUS FOR PERSISTENT CONTROL AND PROTECTION
OF CONTENT

1. Amendment and Response to Office Action (11 pages) w/ Exhibit A (Submission of Replacement Drawings (1 page) and 32 Sheets of Drawings (Figs. 1-32) & Exhibit B (copies of Abstract and Return Receipt Postcard (2 pages);
2. Petition for Extension of Time (1 page);
3. Third Supplemental Information Disclosure Statement (2 pages);
4. Form PTO-1449 (1 page);
5. 9 References (1 Box Total);
6. 3 CD-ROMs containing art cited in two previous IDS's (dated 8/16/99 and 12/20/01); and
7. Please charge \$1,130.00 to Deposit Account No. 06-0916.



Express Mail No.: EV 398888095 US

Dated : March 11, 2004

Attorney: Andrew B. Schwaab

Docket No.: 07451.0011-01000

Mail Drop: CA

Dkt'd ms
03.20.04

Memorandum

Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.

To: File
From: Mary A. McCauley
Date: July 29, 2004
Subject: Transcribed Voice Message

Hello Mr. O'Rourke, my name is Pat Santos, I'm a Patent Examiner with the U.S. Patent and Trademark Office. This is regarding case number 09/276,233. The attorney docket number is 07451.0011-01000.

The reason why I'm calling is because we have not receive a response in several months and it is listed on my docket as available for abandonment and I'm giving you a call to verify if this is indeed the case or if there's a request in the mail or some other situation has occurred. You can give me a call at area code (703) 305-0707.

From: Andrew Schwaab
To: pat.santos@uspto.gov; patrick.santos@uspto.gov
Date: 7/29/04 9:00PM
Subject: 09/276,233 - Amendment was timely filed in this case; DO NOT ABANDON

Examiner Santos:

Thank you VERY much for your courtesy call to Larry O'Rourke of our firm, Finnegan, Henderson et al., regarding Appln. No. 09/276,233; he has referred this matter to me, Andrew Schwaab.

We did, indeed, timely file a full response to your Office action dated Sept. 11, 2003, and the most relevant parts are being attached in PDF format herewith. We have also sent a more complete facsimile of this material to the main USPTO fax number - attention your name, so that will hopefully be a document that can be officially entered. Please note the US Postal Service receipt indicating that this response was deposited March 11, 2004, with all proper certifications to this end also appearing on the filed documents. One Art Unit was actually able to locate the lost amendment, so perhaps a search can be made at the location where this response was last seen (e.g., payment processed, etc.), too?

This is the third or fourth case wherein Group 2100, or perhaps the IDS processing team (most or all of the lost amendments were filed with larger IDS disclosures, and certain officials believe they may be languishing in the IDS scan-in stage), has lost our amendments, and I beginning to become very concerned. I have CC'd Margaret Focarino because we already have one petition to withdraw a holding of abandonment to the Group in this regard (for another case), and this may help her confirm that these lost responses are a reoccurring problem that could hopefully be remedied as quickly and efficiently as possible.

Lastly, in this case, I do note that the mailroom employee appeared to stamp our postcard March 12, 2004, however, again, the stamped US Express Mail receipt clearly shows a deposit of March 11, 2004, and the sworn certifications of US Express Mail deposit, by my secretary Cindy Baglietto, also clearly confirm that this response was US Express Mailed March 11, 2004 and was thus filed in a timely manner.

Again, THANK YOU VERY MUCH for your courtesy call - a simple 20 second call like that (rather than just abandoning the case) avoids countless lost attorney hours and the associated costs for the ever-so-important end users of our Patent System, the applicants, and we all VERY much appreciate your consideration in that regard.

Andrew B. Schwaab
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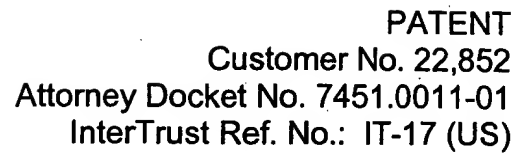
CC: margaret.focarino@uspto.gov

Memorandum

Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.

To: File 07451.0011-01000
From: Andrew B. Schwaab
Date: July 30, 2004
Subject: Abandonment

I called and spoke with Examiner Santos at 8:59 am today, and he said: (1) that he has received my e-mailed copy of the response we filed on March 11, 2004, (2) that he was able to open and view it, and (3) that he would have the response entered into the case. He also said that he did, now, have two boxes of IDS materials, so it appears that our filing must have been received (if those two boxes correspond to the references contained on the CD-ROMs we submitted with the IDS, which they must). He also explained that their Group (2100) did appear to be having problems losing Responses/filings as they are now attempting to transition over to fully electronic file wrappers, so that he would be 'walking' or 'hand walking' some of the papers around/within the Office and that this would result in more phone calls to me/Finnegan when confirmation or explanation of various events was necessary to the processing of the case(s).



Signed: Cindy Baglietto
Cindy Baglietto

Sir:

THIRD SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. § 1.97(c)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(c), Applicants bring to the attention of the Examiner the documents listed on the attached PTO 1449. This Information Disclosure Statement is being filed after the events recited in Section 1.97(b) but, to the undersigned's knowledge, before the mailing date of either a Final action, Quayle action, or a Notice of Allowance. Under the provisions of 37 C.F.R. § 1.97(c), this Information Disclosure Statement is accompanied by a fee of \$180.00 as specified by Section 1.17(p).

Applicants respectfully request that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claims in the application and Applicants determine that the cited documents do not constitute "prior art" under United States law, Applicants reserve the right to present to the office the relevant facts and law regarding the appropriate status of such documents.


Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

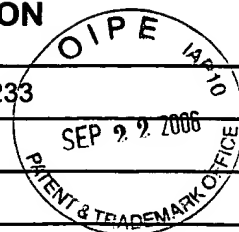
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 11, 2004

By: 
Andrew B. Schwaab
Reg. No. 38,611

INFORMATION DISCLOSURE CITATION

Atty. Docket No.	07451.0011-01000	Appln. No.	09/276,233
Applicant	Talal G. Shamoon, et al.		
Filing Date	March 25, 1999	Group:	2171



Examiner Initial*	Document Number	Issue Date	Name	Class	Sub Class	Filing Date If Appropriate

Examiner Initial*	Document Number	Publication Date	Country	Class	Sub Class	Translation Yes or No
	AU-A-36815/97	02/98	Australia			
	AU-A-36816/97	02/98	Australia			
	AU-A-36840/97	02/98	Australia			
	WO 96/27155	09/96	PCT			
	WO 97/43761	11/97	PCT			
	WO 98/09208 q	03/98	PCT			
	WO 98/10381	3/98	PCT			
	WO 98/37481	08/98	PCT			
	WO 99/24928	05/99	PCT			

Examiner Initial*	OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.)

Examiner	Date Considered
*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.	
Form PTO 1449	Patent and Trademark Office - U.S. Department of Commerce